

REMARKS

Claims 1-84 are all the claims pending in the application. Claims 1-84 have been examined and stand rejected.

I. Amendments to the Claims

Claims 1 to 84 have been amended to more thoroughly define the invention.

II. Information Disclosure Statements (IDS)

The Examiner has returned five IDSs with the August 11, 2004 Office Action. The Examiner has initialed three of the IDSs with a qualification and has not initialed another. The March 3, 2004 IDS has been initialed without qualification.

First, the Examiner has indicated on the Office Action Summary that one of the IDSs has an unknown date. As the Examiner has listed the dates of the four IDSs filed in 2003 and 2004, it appears that the Examiner is referring to the IDS filed on May 9, 2001 listing Japanese patent document 10-121972 as the IDS with the unknown date. This IDS was filed on May 9, 2001 with the application papers and is dated as such on the signature block. Further, Applicant's attorney's review of the private PAIR system indicates that this IDS is listed in the PTO's system as filed on May 9, 2001. Thus, Applicant submits that the Examiner's assertion that this IDS is not dated is in error.

Second, for three of the IDSs, the October 30, 2003, the November 26, 2003 and the May 9, 2001 IDSs, the Examiner has indicated on the initialed copy of form PTO-1449 that the references were considered only to the extent of the Applicant's statement of relevancy. However, such an equivocal consideration is improper. With respect to the October 30, 2003

and the November 26, 2003 IDSs, Applicant submitted an English-language translation of a foreign office action. The MPEP makes clear that this satisfies the Applicant's duty of submitting a concise explanation of the references cited in an IDS:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office.

MPEP 609(III)(A)(3). As stated in the seventh paragraph of MPEP 609, once the minimum requirements of 37 C.F.R. §§ 1.97-1.98 are met, the Examiner has an obligation to consider the information:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

MPEP 609. The MPEP does not provide for a qualified consideration by the Examiner in initialing a reference.

With respect to the May 9, 2001 IDS, the Applicant cites that portion of its specification discussing the reference cited therein. This is a proper concise explanation. As noted above, the MPEP does not allow for equivocation in initialing an IDS.

Finally, with respect to the June 19, 2003 IDS, the Examiner states that no translation and/or statement of relevancy has been provided. Applicant notes for the record that the IDS was filed with an English-language translation of a Japanese office action. While the Examiner states that this is not acceptable in the text of the present Office Action, the Examiner's position is directly contradicted by the MPEP sections cited above. By submitting a translation of the

Japanese office action, Applicant has satisfied its duty of submitting a concise explanation of the references cited in the June 19, 2003 IDS.

Applicant provides with this Amendment clean copies of form PTO-1449 submitted with the IDSs discussed above. Applicant requests that the Examiner initial each IDS without qualification and return them with the next Office Action.

III. 35 U.S.C. § 112 Rejections

Claims 9, 13, 20, 22-25, 31, 38, 48, 49, 53 and 83 have been rejected under 35 U.S.C. § 112, second paragraph. Applicant has amended the rejected claims as shown above. Applicant submits that these amendments overcome the Examiner's rejections.

IV. 35 U.S.C. § 103 Rejections

A. Claims 1-78

The Examiner has objected to claims 1-78 as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,122,591 to Pomerantz ("Pomerantz") in view of U.S. Patent No. 6,430,496 to Smith ("Smith").

As an initial matter, the Examiner has provided no credible motivation to combine the Pomerantz and Smith references. The Examiner asserts that one of ordinary skill would be motivated to combine these references so that a highly automated and efficient system can be realized. However, the Examiner has not identified the source of this motivation.

The teachings of Pomerantz are directed to a taxi trip meter that can detect unscrupulous taxi drivers who, for example, take routes longer than necessary to increase fares. *See* Col. 1, lines 10-17. Pomerantz attempts to solve this problem by determining an actual start time and an actual start location and an actual end time and actual end location. *See* Figs. 2-3. With this

information, Pomerantz's taxi trip meter is able to estimate a fare or trip distance to check against an optimal route distance or fare calculated upon arrival at a destination. The Pomerantz reference contains no teaching of using a central device in its system, i.e., the Pomerantz system is self-contained within the taxi.

Smith, on the other hand, is directed to a system for allowing automation of a dispatching process of vehicles providing transportation services, e.g., ambulances. Smith teaches a system wherein vehicles 20 are dispatched and monitored from a database server 10. *See Fig. 1.*

The Examiner's asserted motivation to combine the references is one of automation and efficiency. This argument, boiled down, is that one of ordinary skill in the art would be motivated to improve the Pomerantz reference by combining its teachings with the teachings of Smith. This is an impermissible hindsight reconstruction of the Applicant's invention. There is no mention of a need for additional automation or efficiency in the Pomerantz reference. Adding a central device to Pomerantz's system would complicate Pomerantz's system. Further, the Pomerantz system is automated. The determinations made in the Pomerantz system occur at trip meter 12, taximeter 11, location sensor 14 and computer 10 and, thus, the system is purportedly automated.. *See Fig. 1.* There is no implied or explicit teaching in Pomerantz that its system would benefit from further automation. The Smith reference purports to disclose a system that eliminates human involvement except in rare instances, thus, Smith teaches a system that is purportedly automated and efficient. Thus, the Examiner's asserted motivation of automation and efficiency cannot come from the Smith reference. Therefore, the Examiner's asserted motivation can only have come from the Applicant's disclosure.

Thus, because the Examiner has provided no credible motivation to combine the Pomerantz reference with the Smith reference, the Examiner's 35 U.S.C. § 103(a) rejection must fail.

Further still, the Smith reference is non-analogous art. To rely on a reference in a 35 U.S.C. § 103 rejection, the reference must be analogous prior art. MPEP 2141.019(a). The present invention, in general terms, relates to a system for finding optimal routes from a starting point to a destination for use in a vehicle. The Pomerantz reference relates to a system for, upon arrival at a destination, determining an optimal route for purposes of ensuring a customer is paying an appropriate fare. However, the Smith reference relates to a system of dispatching an appropriate vehicle to pick up a package. Smith does not in any way relate to a system for determining routes. One of ordinary skill would not look to the dispatching system art when endeavoring to create an improved system for determining routes as discussed in the present application. Thus, the Smith reference is not in the Applicant's field of endeavor and cannot be used as part of a 35 U.S.C. § 103 rejection. As the Smith reference is non-analogous art, and as the Examiner acknowledges deficiencies in the Pomerantz reference with respect to claims 1-78, the Examiner's rejection must fail for this additional reason.

In addition to the above reasons, Applicant submits that the claims are patentable over Pomerantz in view of Smith for at least the additional reasons.

1. Claim 1-8, 18-19, 22-23, 26-27, 30, 32, 34 and 36

With respect to claim 1, a combination of Pomerantz and Smith would fail to result in a system as recited in claim 1. Neither reference discloses a center equipment configured to

receive present-location information and destination information from a vehicle as recited in claim 1. Pomerantz discloses no structure that would correspond to the claimed center equipment as the Examiner acknowledged. Smith's database server 10 does not receive destination information indicating a destination specified by a customer from a vehicle. Thus, as neither reference teaches this element of claim 1, the rejection must fail for at least this additional reason.

Furthermore, with respect to claim 5, contrary to the Examiner's assertion, the Pomerantz system does not teach each element of claim 5. In Pomerantz, there is only one "optimal" route found; the route determined upon arrival at a destination end point. If a change occurs en route to an original destination, the location sensor 13 of the Pomerantz system would not detect a new current location nor would it transmit this new current location to a center equipment.

Furthermore, should a change be made en route to the original destination, there would be no new optimal route determined. The "optimal" route would only be found upon arrival at the new destination. Therefore, Applicant submits that Pomerantz does not teach a system capable of calculating a new optimal route as recited in claim 5.

As claims 6-8, 18-19, 22-23, 26-27, 30, 32, 34 and 36 depend on claim 5 and as claims 2-8, 18-19, 22-23, 26-27, 30, 32, 34 depend on claim 1, Applicant submits that claims 2-8, 18-19, 22-23, 26-27, 30, 32, 34 and 36 are patentable over the cited art at least based on the dependencies.

Accordingly, Applicant submits that claims 1-8, 18-19, 22-23, 26-27, 30, 32, 34 and 36 are patentable over Pomerantz in view of Smith for at least these additional reasons.

2. Claims 9-17, 20-21, 24-25, 28-29, 31, 33, 35 and 37

In addition to the reasons cited above, Applicant submits that claims 9-17, 20-21, 24-25, 28-29, 31, 33, 35 and 37 are patentable over Pomerantz in view of Smith for at least the following additional reasons.

With respect to claim 9, the combination of Pomerantz and Smith fails to teach or suggest a system as recited in claim 9. Claim 9 recites a center equipment configured to find multiple different optimal routes. Assuming the references can be combined as the Examiner asserts, there is no teaching or suggestion in either reference of a center equipment that finds multiple optimal routes. These different optimal routes could include, as illustrated in one non-limiting exemplary embodiment of the specification, the least expensive route, the quickest route (time) and the shortest route (distance). Pomerantz teaches finding an “optimal” route based on start and end points once the vehicle is actually at the end point. There is no teaching of calculating multiple optimal routes as recited in claim 9. Smith does not mention calculating optimal routes. Therefore, the combination of Smith and Pomerantz fails to teach or suggest each element 9.

Furthermore, with respect to claim 13, contrary to the Examiner’s assertion, the Pomerantz system does not teach each element of claim 13. In Pomerantz, there is only one “optimal” route found; the route determined upon arrival at a destination end point. If a change occurs en route to an original destination, the location sensor 13 of Pomerantz system would not detect a new current location nor would it transmit this new current location to a center equipment. Furthermore, should a change be made en route to the original destination, there

would be no new optimal route determined. The “optimal” route would only be found upon arrival at the new destination.

As claims 10-17, 20-21, 24-25, 28-29, 31, 33, 35 depend on claim 9 and as claims 14-17, 20-21, 24-25, 28-29, 31, 33, 35 depend on claim 13, Applicant submits that claims 10-17, 20-21, 24-25, 28-29, 31, 33, 35 are patentable over the cited art at least based on these dependencies.

Accordingly, Applicant submits that claims 9, 13-17, 20-21, 24-25, 28-29, 31, 33, 35 and 37 are patentable over Pomerantz in view of Smith for at least these additional reasons.

3. Claims 38-47

In addition to the reasons cited above, Applicant submits that claims 38-47 are patentable over Pomerantz in view of Smith for at least the following additional reasons.

The combination of Pomerantz and Smith fails to teach or suggest each element of claim 38. Claim 38 recites a method which includes the step of transmitting from a vehicle information indicating a destination specified by a customer. Pomerantz does not disclose transmitting destination information specified by a customer. In Pomerantz, a destination end point is determined by location sensor 13 and this end point is transmitted to computer 13. However, this destination end point does not correspond to a destination specified by a customer. In Pomerantz, the actual destination end point is the actual physical location of the taxi at the end of its trip. This does not need to correspond to a destination provided by a customer. For example, a customer could specify an end point of 17th Street and Pennsylvania Ave; this would be one example of destination information specified by a customer. However, because of, for example, security concerns, a taxi may only be able to a customer to 19th Street and

Pennsylvania Ave., two blocks away from the customer's specified destination. Thus, the actual destination in Pomerantz is different than that information to be transmitted according to claim 38. Smith does not cure this deficiency.

With respect to claim 40, even assuming Smith and Pomerantz can be combined as asserted by the Examiner, the combination does not teach or suggest a method that would enable a charge before a transportation service is provided. Pomerantz teaches calculating fares only after arrival at a destination. Smith creates an invoice only after services are provided. Neither system would result in a method wherein a customer would be able to pay a charge before services are provided.

The Examiner's assertion that, for example, airlines require passengers to pay fares prior to flying, ignores the dependency of claim 40 on claims 38 and 39. The Examiner cannot simply look at the element introduced into claim 40 to state that that element would have been obvious. This approach impermissibly fails to look at the claim as a whole.

As claims 39-47 depend on claim 38 and as claim 41-47 depend on claim 40, Applicant submits that these claims are patentable over the cited art at least based on these dependencies.

Accordingly, Applicant submits that claims 38-47 are patentable over the cited art.

4. Claim 48-58

As discussed above with respect to claim 9, the combination of Pomerantz and Smith fails to teach or suggest a system configured to calculate multiple optimal routes. For analogous reasons, Applicant submits that Pomerantz in view of Smith fails to teach a method that includes the step of finding multiple optimal routes for a plurality of criteria.

Claims 49-58, which depend on claim 48, are patentable over the cited art at least based on this dependency.

5. Claim 59-78

With respect to claim 59, as discussed above, Pomerantz in view of Smith fails to teach or suggest a method wherein a plurality of routes are found. Pomerantz teaches only the determination of one optimal route. Smith does not teach calculation of optimal routes. Therefore, the combination of Pomerantz and Smith does not teach or suggest a method including a step of finding multiple optimal routes. Claims 60-62, 67-68, 71, 73, 75 and 77 being dependent from claim 59 are patentable over the cited art at least based on this dependency.

For reasons analogous to those presented with respect to claim 59, Applicant submits that Pomerantz in view of Smith fails to disclose a method according to claim 63. Claims 64-70, 72, 74, 78 being dependent on claim 59 are therefore patentable over the cited art at least based on this dependency.

B. Claims 79-82

Claims 79-82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pomerantz. The Examiner asserts that Pomerantz discloses a method wherein customers can be informed of a fare charge prior to embarking on the trip. However, this is not what Pomerantz discloses. In Pomerantz, the estimated fare, which serves as a threshold fare to evaluate the actual fare, is determined only after trip ends. *See* Fig. 3 at steps 45, 53-54; col. 3, lines 30-48. The actual fare to be paid by the customer is also determined after the end of the trip. *Id.* Thus,

Pomerantz does not teach a system wherein a charge is paid by a customer before transportation services are provided. Accordingly, Applicant submits that claims 79-82 are patentable over Pomerantz.

C. Claims 83-84

Claim 83-84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pomerantz in view of U.S. Patent No. 5,802,492 to DeLorme et al. (“DeLorme”).

As DeLorme fails to cure the deficiencies of Pomerantz set forth above with respect to claims 79-82, Applicant submits that claims 83-84 are patentable over Pomerantz in view of DeLorme.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No.: 09/851,248

Attorney Docket # Q64412

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Brandon M. White
Registration No. 52,354

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 4, 2004